

Serial Number: 09/721.027

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REMARKS

Upon entry of the present Response, claims 1-3, 5-8, 10-13, and 15-20 remain pending in the present application. Claims 1, 7, and 13 have been amended. Applicant respectfully requests reconsideration of the pending claims in view of the following remarks.

In item 4 of the Office Action, claim 14 has been rejected under 35 U.S.C. §112, 1st paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action states:

"Claim 14 is directed to "positioning a graphical depiction of an assembly of a picture book from the picture book cutout itself into the digital picture book template, where the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book." The claimed limitation is not consistent with the disclosure of the invention since the specification (page 11, lines 15-21) and the drawing (figure 8, #359) disclose placing the image and/or text in the particular page of the picture book template, not positioning the graphical depiction of an assembly of a picture book into the digital picture book template as claimed." (Office Action, page 2.)

Applicants respectfully disagree. Specifically, with reference to discussion block 343 of FIG. 8, the specification states:

"With reference to FIG. 8, shown is a flowchart of the book assembly logic 256, according to an aspect of the present invention. The book assembly logic 256 is executed by the server 203 (FIG. 3) as a component of the book assembly system 236 (FIG. 3). Specifically, the book assembly logic 256 is executed to construct the picture book template 100 (FIG. 1) in a digital format that may be transmitted to the client 206 for printing. Beginning with block 243, the book assembly logic 256 obtains the instructions 109 and the graphical depiction 113 of the instructions to include the instructions region 106. The instructions and the graphical depiction 113 are obtained, for example, from the memory 226 (FIG. 3). Thereafter the book assembly logic 256 moves to block 346 in which the header instructions 109 and the graphical depiction 113 are placed in the instructions region 106 of the picture book template 100. Thereafter, in block 349, the identifier lines 119 are placed in the picture book template 100, thereby defining the pages 116."

Thus, the logic described involves placing the graphical depiction of the assembly of the picture book and the picture book cut out itself into the digital picture book template as described. Accordingly, Applicants request that the rejection of claims 14 under 35 U.S.C. §112 be withdrawn.

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In item 7 of the Office Action, claims 18-20 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Specifically, the Office Action states:

"Claims 18-20 are directed to a picture book template, which is merely non-functional descriptive material, and thus non-statutory." (Office Action, page 3.)

Applicants respectfully disagree. Specifically, claim 18 provides as follows:

18. A picture book template for creating a picture book, comprising:
a picture book cutout having a number of pages, the pages defined by a number of identifier lines;
an instructions region including assembly instructions;
a graphical depiction of an assembly of the picture book from the picture book cutout, wherein the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book.

It has long been held that not all inventions involving printed matter on a substrate or paper are non-statutory subject matter. In this respect, in *Flood v. Coe*, 45 U.S.P.Q. 72 (D.D.C. 1940), the Federal Court for the District of Columbia held that a ticket with lines of perforations extending along the length was patentable subject matter. In relevant part, the court stated:

"The invention here is more than an arrangement of printed matter on the piece of matter. There is a definite and decided relationship between the physical structure and the printed matter. The one depends upon the other. In other words, there is a cooperative relationship between the printed indicia and the structural features of the ticket, page 73."

Flood involved a price ticket for tagging garments in retail stores. The ticket was formed in two parts with a perforated line between the two portions. Each part of the ticket carried an identical series of identification indicia and the price mark.

The subject matter of claims 18-20 is statutory subject matter under §101 in the manner that the price ticket of *Flood* was a statutory subject matter. Specifically, there is a relationship between the physical structure of the cut out and the printed matter thereon. Specifically, the picture book cutout has a number of pages that are defined by the number of identifier lines on the page. The identifier lines indicate locations where the cutout is to be folded to create the structure of the picture book. In addition, the instructions region that includes assembly instructions on the page

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that illustrate how to construct the picture book claimed, where the identifier lines on the pages are also shown in the graphical depiction.

Accordingly, Applicants assert that the rejection of claims 18-20 under 35 U.S.C. §101 is improper. Accordingly, Applicants request that this rejection be withdrawn.

Next in item 9 of the Office Action, claims 18-19 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,327,599 issued to Warmus et al. (hereafter "*Warmus*"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). For the reasons that follow Applicants assert that the rejection of claims 18-19 above is improper. Accordingly, Applicants request that the rejection of these claims be withdrawn.

To begin, claim 18 provides as follows:

18. A picture book template for creating a picture book, comprising:
- a picture book cutout having a number of pages, the pages defined by a number of identifier lines;
 - an instructions region including assembly instructions;
 - a graphical depiction of an assembly of the picture book from the picture book cutout, wherein the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book.

With respect to claim 18, the Office Action states:

"Regarding independent claim 18, Warmus discloses:

- a picture book cutout having a number of pages, the pages defined by a number of identifier lines (figures 6a-b, 7a-b, 8a-b, col 7: the pages are defined by the folded lines in a picture book cutout)
- an instruction region including assembly instructions (col 3, line 35 to col 4, line 3: means for assembling implies that such means includes assembly instructions; col 6, lines 25-30: device interface for assembling the pages to produce finished books implies that the device interface includes assembling instructions (associated with the book template)
- a graphical depiction of an assembly of the picture book from the picture book cutout, wherein the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book (col 7, lines 5-67 and figures 6a-b, 7a-b, 8a-b: the printed forms in these figures show the graphical depiction of an assembly of a picture book where the dotted lines 102, 119a-b are identifier lines to indicate where the

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paper sheet should be folded and trimmed to assembly pages of a book version)." (Office Action, page 3 – page 4.)

First, the "fold line 102" of *Warmus* is not an actual physical line on the page. Rather, the fold line is shown in FIGS. 6a-8b for purposes of illustration. In fact, *Warmus* discusses an automated system that performs various finishing operations and folds the documents as shown. Applicants assert that the machines described by *Warmus* do not "read" or comprehend the significance of any line on any document. Rather, the pages that are fed to the machines do not actually have lines where folding is to occur. The fold lines shown in the patent are merely to illustrate where the fold is in the patent itself for better comprehension. As understood by one skilled in the art, the machines take pages of known size and perform the finishing operations such as folding, as per the original design. Thus, Applicants assert that *Warmus* fails to show or suggest a picture book cut out having a number of pages, where the pages are defined by a number of identifier lines as claimed.

In addition, *Warmus* fails to show or suggest the instruction region that includes assembly instructions as per claim 18 above. Specifically, the Office Action cites col. 3, lines 35 to col. 4, line 3 as showing this element. However, Applicants respectfully disagree. Specifically, at col. 3, lines 35 to col. 4, line 3, *Warmus* states:

"According to a further aspect of the present invention, an apparatus for controlling an electronic press wherein the press includes a controller responsive to press commands includes first means for developing a template file defining pages to be printed with fixed information common to all of the associated pages and variable information unique to each page, as well as means for assembling a database having entries therein each representing variable information to be printed. Second means are responsive to the first developing means for developing a master page file from the template file wherein the master page file defines the fixed information. Means are responsive to the assembling means and the first developing means for converting the template file and the database into press commands specifying sequence and content of page production by the press.

In accordance with yet another aspect of the present invention, an apparatus for controlling an electronic press wherein the press includes a controller responsive to press commands includes first means for developing a plurality of template files each defining associated pages to be printed with and having a first data defining fixed information common to all of the associated pages and variable information unique to each associated page. At least one of the template files further includes second data defining a particular area in each associated page for the printing of variable

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information therein and third data identifying at least one of the database entries. Means are provided for assembling a database having entries therein each representing variable information to be printed. Second means are responsive to the first developing means for developing a master page file from the template file wherein the master page files includes data defining the fixed information only. Means are responsive to the assembling means and the first developing means for converting the template files and the database into press commands specifying sequence and content of page production by the press." (U.S. Patent 6,327,599, col. 3, line 35 – col. 4, line 3).

The Office Action states that the "means for assembling as described in the above excerpt implies that such means includes assembly instructions." Applicants respectfully disagree. The "means for assembling" is not means for assembling a document, rather, the means for assembling described above is "means for assembling a database having entries therein, each representing variable information to be printed". In addition, Applicants assert that the assertion by the Examiner that means for assembling necessary implies that such means includes assembly instructions on the document as claimed is simply inaccurate. Why would a machine that automatically constructs pages need to "read" instructions. To assume that the assembly instructions are "implied" as set forth in the Office Action would be to attribute much greater intelligence than that which they actually possess. Rather, the machines perform specific finishing applications for which they were designed. There is no need for instructions to be placed on the documents themselves, and, in fact Warmus does not show or suggest the placement of assembly instructions on the documents at all. Also, Applicants assert that given that the machines do not read the written word, there is no implication as asserted that such means includes assembly instructions.

In addition, the assertion that *Warmus* shows the graphical depiction of assembly of the picture book from the picture book cut out, where the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book is incorrect. Specifically, as stated above, the dotted lines 102 are not actual lines on the pages, rather they are lines in the drawings representing folds to facilitate the discussion of the patent application. Applicants assert that there are no actual lines on the documents as fed to machines for automated processing.

In addition, the dotted lines alone do not show an "graphical depiction of an assembly of the picture book from the picture book cut out." Rather, the lines only

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show the partition between pages. They do not show how to assemble the pages themselves. Also, in the graphical depiction the indicated lines are not shown in conjunction with lines on the pages as set forth in the present invention and claimed herein.

Accordingly, Applicants assert that the rejection of claim 18 is improper. Therefore, Applicants request that the rejection of claim 18 be withdrawn. In addition, Applicants request that the rejection of claim 19 be withdrawn as depending from claim 18.

In item 12 of the Office Action, claims 1-17, and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Warmus*. A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rlickaert, 9 F.3d 1531, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). Claims 4, 9, and 14 have been canceled herein, thereby rendering this grounds of rejection moot with respect to such claims. In addition, Applicants assert that *Warmus* fails to show or suggest each of the elements of claims 1, 7, and 13, as amended herein. Also, Applicants assert that *Warmus* fails to show or suggest each of the elements of claims 2-3, 5-6, 8, 10-12, and 15-17 as depending from claims 1, 7, and 13. In addition, Applicants assert that *Warmus* fails to show or suggest the elements of claim 20 as depending from claim 18.

To begin, claim 13, as amended, provides as follows:

13. A method for creating a digital picture book template in a server, comprising the steps of:
obtaining a number of content items in a server to be depicted in a picture book cutout in the digital picture book template;
defining a number of pages of the picture book cutout in the server with a number of identifier lines;
associating at least one of the content items with at least one of the pages; and
associating a set of assembly instructions with the digital picture book template by positioning a graphical depiction of an assembly of a picture book from the picture book cutout into the digital picture book template, wherein the identifier lines are additionally depicted in the graphical depiction, the identifier lines as depicted in the graphical depiction corresponding to the identifier lines of the picture book cutout to aid an individual in the assembly of the picture book.

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As shown above, claim 13 provides for the step of associating set of assembly instructions with a digital picture book template by positioning a graphical depiction of an assembly of a picture book from the picture book cut out into the digital picture book template, wherein the identifier lines are additionally depicted in the graphical depiction, the identifier lines as depicted in the graphical depiction corresponding to the identifier lines of the picture book cut outs to aid an individual in the assembly of the picture book. In this respect, claim 13 specifies that the identifier lines are additionally depicted by the graphical depiction and that they correspond to the identifier lines of the picture book cut out itself. In this respect, the assembly instructions aid an individual in the assembly of the picture book.

Applicants assert that *Warmus* fails to show or suggest at least this element. Specifically, *Warmus* discusses an automated system that does not read graphical depictions in order to obtain instructions of how to assemble a picture book. Also, there are no instructions depicted by *Warmus*, and further no identifier lines are depicted in the graphical depiction associated with the instructions where the identifier lines as depicted in the graphical depiction correspond to the identifier lines on the picture book cut out itself.

Accordingly, Applicants assert that *Warmus* fails to show or suggest each of the elements of claim 13. In addition, Applicants assert that *Warmus* fails to show or suggest each of the elements of claims 1, and 7 to the extent that they recite the identifier lines being additionally depicted in the graphical depiction, where the identifier lines as depicted in the graphical depiction correspond to the identifier lines of the picture book cut out to aid an individual in the assembly of the picture book. Accordingly, Applicants request the rejection of claims 1, 7, and 13 be withdrawn. In addition, Applicants request that the rejection of claims 2-3, 5-6, 8, 10-12, and 15-17 be withdrawn.

In addition, Applicants assert that *Warmus* fails to show or suggest each of the elements of claim 20 as depending from claim 18 for the reasons described above with respect to claim 18. Accordingly, Applicants request that the rejection of claim 20 be withdrawn.

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Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding this Response, the Examiner is encouraged to telephone the undersigned counsel of Applicants.

Respectfully submitted,



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